

EXPEDITED PROCEDURE – EXAMINING GROUP 3696

S/N 09/905,046

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Christine Cheng et al.	Examiner:	Ojo O. Oyeibisi
Serial No.:	09/905,046	Group Art Unit:	3696
Filed:	July 12, 2001	Docket No.:	2043.258US1
Title:	METHOD AND APPARATUS TO DETECT SUSPICIOUS TRANSACTION WITHIN A NETWORK-BASED AUCTION FACILITY		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below:

REJECTION OF CLAIMS 1-6, 31-36, AND 40 UNDER §102(B) AS BEING ANTICIPATED BY TROSTLE IS CLEARLY NOT PROPER AND WITHOUT BASIS BECAUSE TROSTLE DOES NOT DISCLOSE EVERY ELEMENT OF THE REJECTED CLAIMS

Claims 1-6, 31-36 and 40 were rejected under 35 U.S.C. § 102(b) for anticipation by Trostle (U.S. 5,919,257).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration, *In re Dillon*.¹

Concerning independent claims 1, 31, 32, 33, and 40:

Applicants believe that the issue of patentability of independent claims 1, 31, 32, 33, and 40 over Trostle is best understood with regard to independent claim 1.

Independent claim 1 includes the following limitations:

¹ 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

causing a first identifier associated with a first user identity to be stored on a machine responsive to a first sales-related event ...;

detecting a potentially fraudulent activity by detecting a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity responsive to a second sales-related event with respect to the network-based transaction facility and initiated under the second user identity from the machine.

The Final Office Action maintains that that the above limitations are disclosed by Trostle in col. 5, lines 45 – 67 (cited below).

“FIG. 5 is a flow chart illustration of the login process based upon NDS authentication employed in NetWare 4.1. In step 82, a username prompt is presented to the user. In response, the user enters a username, which is transmitted to the server and in step 84 the server compares the entered username against a list of authorized users. If the username is not valid, network access is denied in step 86 and the login process ends. However, if the entered username is on the list, the server returns an encrypted private key to the workstation in step 88. The encrypted private key can only be decrypted with the user's password. In step 90 the server checks if any login restrictions, such as time restrictions, station restrictions, and account lockout restrictions have been violated. These restrictions prevent logins from unauthorized workstations or logins during the wrong time of day. If there are violations, access is denied (step 86). However, if there are no login restrictions, the user is prompted to enter a password in step 92 and the validity of password is determined in step 942.”

Trostle, apparently, relates to a two-step login process. Instead of requiring a user to enter his username and password at once, the user is prompted to enter his username first. The username is then transmitted to the server and is validated against a list of authorized usernames. If the username is not among the authorized usernames, the access is denied. Otherwise, an encrypted private key is transmitted to the client system that can only be decrypted with the user password.

Thus, the login process proposed in Trostle relates to denying user access based on a **single unauthorized user id**. On the contrary, independent claim 1 requires “***a first user identity***” and “***a second user identity***”. Furthermore, besides requiring “***a first user identity***” and “***a second user identity***”, independent claims 1 requires “***detecting a potentially fraudulent***

activity by detecting a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity. Trostle, on the other hand, is concerned with whether its single user id is among the “authorized users”. Thus, it is clear that a single user id of Trostle cannot be reasonably characterized as “a first user identity” and “a second user identity” cited by independent claim 1.

Moreover, Trostle **denies user access** if the user id is not found in the list of authorized users. Contrary to Trostle, independent claim 1 does not require denying user access whether or not there is “a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity”. Instead, independent claim 1 requires “*detecting a potentially fraudulent activity*”.

For at least the reasons stated above, Trostle fails to disclose all limitations of independent claim 1, and therefore the rejection of claims 1, 31, 32, 33, and 40 as anticipated by Trostle is improper and should be withdrawn.

Concerning claims 2-6 and 34-36:

Applicants respectfully submit that claims 2-6 and 34-36 depend directly or indirectly from independent claims 1 and 33. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Applicants submit that these dependent claims are patentable for at least the reasons set forth above.

Thus, Applicants respectfully request withdrawal of the rejections of claims 2-6 and 34-36. For brevity, Applicants reserve the right to present further remarks concerning the patentable distinctiveness of such dependent claims.

REJECTION OF CLAIMS 7- 9, 19-20, 30, AND 37- 40 UNDER §103 AS BEING UNPATENTABLE OVER PRIOR ART IS CLEARLY NOT PROPER AND WITHOUT BASIS BECAUSE THE FINAL OFFICE ACTION DID NOT EXPLAIN WHY THE DIFFERENCES BETWEEN THE PRIOR ART AND THE REJECTED CLAIMS WOULD HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. In re Young³. Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences, which one skilled in the art would reasonably be expected to draw therefrom. In re Preda⁴. Thus, what is required in the analysis is "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" and not "precise teachings directed to the specific subject matter of the challenged claim" when inferences and creative steps that a person of ordinary skill in the art would employ are taken into consideration⁵. KSR Int'l Co. v. Teleflex Inc.

Claims 7-8 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner et al. (Discovering Internet marketing intelligence through online analytical web usage mining, ACM SIGMOD Record archive, Vol. 27, Issue 4, (December 1998), Pages: 51-61), hereinafter Buchner. Claims 9-19 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner as applied to claims 8 and 37 above, and further in view of Miller (Michael Miller, The complete Idiot's Guide to Ebay Online Auctions, copyright July 1999). Claims 20-30 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner and Miller as applied to claims 19 and 38 above, and in further view of Smaha et al (U.S. 5,557,742), hereinafter Smaha. Applicants respectfully traverse these rejections.

Applicants respectfully submit that Trostle, Buchner, Miller, and Smaha when combined fail to teach or suggest all of the limitations of the rejected claims. Applicants believe that they showed that Trostle fails to disclose elements of independent claims 1, and 33 from which dependent claims 7- 9, 19-20, 30, and 37- 40 depend either directly or indirectly. The Final Office Action alleges that Buchner, Miller, and Smaha teach certain additional elements but is silent as to why Trostle, Buchner, Miller, and Smaha when combined would teach or suggest elements that Applicants showed as lacking in Trostle.

The MPEP states that the prior art reference (or references when combined) need not

³ 927 F.2d 588,591,18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413,425,208 USPQ 87 1, 881 (CCPA 1981)

⁴ 401 F.2d 825,826, 159 USPQ 342,344 (CCPA 1968)

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Page 5

Dkt: 2043.258US1

teach or suggest all the claimed limitations. However, according to the same section of MPEP, Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* to one of ordinary skill in the art. MPEP § 2141. The Final Office Action does not explain why the differences between the combination of Trostle, Buchner, Miller, and Smaha and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art. Accordingly, Applicants respectfully request that the obviousness rejection of claims 7- 9, 19-20, 30, and 37- 40 be withdrawn.

1 127 S. Ct. 1727,82 USPQ2d 1385,1396 (2007)

CONCLUSION

Applicant respectfully submits that all of the pending claims are in condition for allowance, and the reversal of the rejection made by the Final Office Action is earnestly solicited. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

By Their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10 day of June, 2008.

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